AMENDMENTS

Please replace claim 69 with the following:

69. (amended) The method of claim 57, wherein at least one of the web objects comprises an electronic file.

Please replace claim 92 with the following:

92. (amended) The programmable storage device of claim 91, wherein the Web page and the Web objects of the Web page are stored in contiguous positions on the cylinder of the magnetic disk.

Please replace claim 93 with the following:

93. (amended) The programmable storage device of claim 91, wherein the magnetic disk has a plurality of cylinders, and the Web page and Web objects of the Web page are stored on closely spaced cylinders.

Please replace claim 94 with the following:

94. (amended) The programmable storage device of claim 91, wherein the magnetic disk has a plurality of cylinders, and the Web page and Web objects of the Web page are stored contiguously on multiple cylinders.

REMARKS

In the Office Action mailed September 9, 2003 the Examiner: objected to claim 69 under 37 CFR 1.75(c) as being of improper dependant form; rejected claims 92, 93, and 94 under 35 USC § 112 as having insufficient antecedent basis for certain limitations; rejected claims 40-46, 48-63, 65-76, 78-79, and 91-95 under 35 USC 103(a) as obvious in view the Mantha and Ganger references.

Objections under 37 CFR 1.75(c) and rejections under 35 USC §112

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Applicant believes that the above amendments to correct errors in the claims overcome the Examiner's claim objection under 37 CFR 1.75(c) and claim rejections under 35 USC §112.

Rejections under 35 USC 103(a)

A prima facie case of obviousness must include: some suggestion or motivation to modify the reference or to combine reference teachings; a reasonable expectation of success; the prior art reference or references must teach or suggest all of the claim limitations. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). The Office Action does not provide reasoning indicating any suggestion or motivation to combine these references or any reasonable expectation of success. Furthermore, the Mantha and Gnager references, when combined, do not teach or suggest all of the claim limitations in any of claims 40-46, 48-63, 65-76, 78-79, or 91-95.

The Office Action states that it would have been obvious at the time of the invention to modify Mantha with the teachings of Ganger because the teachings of Ganger improved disk performance in certain circumstances, but the Office Action does not state where the suggestion to combine these references appears in the prior art. (*Office Action mailed 9/04/03*, page 5) Therefore, this assertion appears to have no basis other than impermissible hindsight and hence does not provide the required suggestion to combine the Mantha and Ganger references, nor is such a suggestion to combine found anywhere else in the prior art.

If the teachings of Ganger were as obviously applicable to any storing of data as the Office Action implies then these teachings would have been incorporated into the later Mantha reference's teachings. Because the Office Action does not provide a suggestion to combine the references it does not constitute a prima facie case of obviousness.

The Office Action does not provide sound reasoning as to a reasonable expectation of

success from the combination of the Mantha and Ganger references. The Ganger reference specifically states that the methods it teaches are beneficial only in the retrieval of small files. This limitation is even present in the title itself: "Embedded Inodes and Explicit Grouping: Exploiting Disk Bandwidth for Small Files." Ganger is directed solely at the potential for benefits in operation when "the data blocks of multiple **small files** named by a given **directory** are allocated adjacently." (*Ganger*, Abstract, emphasis added) This teaches away from the invention claimed in the current application that sees benefit from co-locating files with correlated retrieval times, not the directory in which they are filed, regardless of their size. Because the Office Action does not provide a reasonable likelihood of success for the combination of references it does not constitute a prima facie case of obviousness.

Even if the Office Action presented a suggestion to combine the Mantha and Ganger references and a reasonable likelihood of success of such a combination, the combined references still would not teach each and every element of the claims as Ganger does not teach storing objects having correlated retrieval times in collocated positions on a storage device. The abstract of Ganger only mentions locating "the data blocks of small files **named by a given directory**" adjacently. (*Ganger*, Abstract, emphasis added) This is not the same as identifying Web Objects having correlated retrieval times to the web page and storing those web objects in co-located positions on a storage device. At page 2 in the Introduction, Ganger further decribes a method which co-locates only "files whose inodes are embedded in the same directory." (Ganger, page 2, section 1 - Introduction) This does not indicate co-location of files having retrieval times that are correlated to those of a web page.
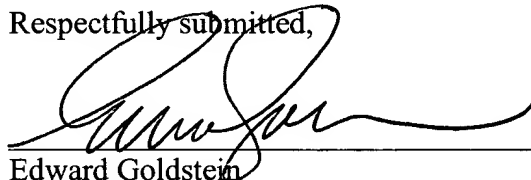
Furthermore, Mantha teaches a method of saving a web page to enable client side browsing, not a method of storing web objects in general. Mantha does not teach identifying

Web objects having correlated retrieval times and storing them in co-located positions, but instead teaches only the saving of embedded objects. (Mantha, Summary of the Invention) Because Mantha teaches a method of saving a web page to enable client side browsing, Mantha does not teach storing the original web page but rather a modified version of that web page. (Mantha, Summary of the Invention) The method taught in Mantha requires each saved web page to be modified by replacing the original hypertext references with new references pointing to the locally stored copies of embedded objects. (Mantha, Summary of the Invention) This modification of the original web page teaches away from applicant's method which allows remote as well as local caching of web objects. Because the Mantha and Ganger prior art references in combination do not teach or suggest all of the claim limitations in any of the claims of the present application, a prima facie case of obviousness has not been set forth.

In view of the above, each of the claims in this application is believed to be in condition for allowance. Accordingly, the examiner is respectfully requested to withdraw the outstanding rejections of the claims and to pass this application to issue.

Respectfully submitted,

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MARKED UP VERSIONS OF AMENDMENTS

69. (amended) The method of claim [56]57, wherein at least one of the web objects comprises an electronic file.

92. (amended) The programmable storage device of claim [83]91, wherein the Web page and the Web objects of the Web page are stored in contiguous positions on the cylinder of the magnetic disk.

93. (amended) The programmable storage device of claim [83]91, wherein the magnetic disk has a plurality of cylinders, and the Web page and Web objects of the Web page are stored on closely spaced cylinders.

94. (amended) The programmable storage device of claim [83]91, wherein the magnetic disk has a plurality of cylinders, and the Web page and Web objects of the Web page are stored contiguously on multiple cylinders.